

REMARKS

This Amendment is in response to the Final Office Action mailed July 19, 2006. Claims 1-7, 9, 11-16, and 18-22 were examined in the Office Action. Claims 1-7, 9, 11-16, and 18-22 were rejected. Claims 1-7, 9, 11-16, and 18-22 remain pending in this case. Applicant respectfully requests reconsideration and examination in view of the following remarks.

Claim Rejections- 35 U.S.C. §103

Claims 1-7, 9, 11-16, and 18-22 are rejected under 35 U.S.C. §103 (a) as being unpatentable over Nagendran, U.S. Patent Number 6,731,940 B1 (hereinafter "*Nagendran*") and in view of Brody et al., U.S. Patent Number 4,670,899 (hereinafter "*Brody*"). Applicants respectfully traverse this rejection.

Regarding Claims 1, 13, and 19 the Office Action merely states that it is inherent (from *Nagendran*) in the area of Cellular Communications that when a mobile device is in the active state and ready to communicate that the network that an entry node provides information to the mobile device in regards to the channel on which the device should transmit. (See Office Action page 2, lines 20-23; page 7, lines 9-12.) Applicant respectfully submits that inherency requires inevitably. Thus, to be inherent the alleged result must be inevitable from the operation disclosed or the inherent characteristic must be inevitably present in the device. (See *Akamai Technologies, Inc. v. Cable & Wireless Internet Serv., Inc.*, 344 F.3d 1186, 1192, 68 USPQ2d 1186, 1190 (Fed. Cir. 2003) ("A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present.") (See also MPEP 2112 IV).

Applicant respectfully submits that, even if an entry node provides information to the mobile device in regards to the channel on which the device should transmit were possible, it is not inevitable from *Nagendran* that the entry node provides information to the mobile device in regards to the channel in which the mobile device should transmit on. While embodiments of Applicant's invention do not necessarily perform in this manner, it is possible, for example, that a mobile device can transmit on a single channel and the entry node can accept communications from multiple channels.

Furthermore, regarding Claim 13, the Office Action merely states that it is inherent (from *Nagendran*) the area of Cellular Communications that when a mobile device is in the active state, the service provider recognizes the mobile device's presence by sending out signals to the mobile device. (See Office Action page 6, lines 15-18.) Again, Applicant respectfully submits that inherency requires inevitably. Thus, to be inherent the alleged result must be inevitable from the operation disclosed or the inherent characteristic must be inevitably present in the device. (See *Akamai Technologies, Inc. v. Cable & Wireless Internet Serv., Inc.*, 344 F.3d 1186, 1192, 68 USPQ2d 1186, 1190 (Fed. Cir. 2003) ("A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present.") Applicant respectfully submits that, even if the Office Action's contention were true that when a mobile device is in the active state, the service provider recognizes the mobile device's presence by sending out signals, it is not inevitable from *Nagendran* that the service provider recognizes the mobile device's presence by sending out signals to the mobile device. While embodiments of Applicant's invention do not necessarily perform in this manner, it is possible, for example, that a mobile device's presence is detected after the mobile device sends a signal to the service provider.

As a result, Applicants respectfully assert that the Office Action has failed to make a *prima facie* case of obviousness regarding independent Claims 1, 13, and 19. Furthermore, In order to make a *prima facie* case of obviousness, the Examiner must set forth prior art which teach or suggest every claim limitation. (See MPEP § 2143).

Dependent Claims 2-7, 9, 11-12, 14-16, 18, and 20-22

Regarding claims 2-7, 9, 11-12, 14-16, 18, and 20-22, Applicant submits that claims 2-7, 9, 11-12, 14-16, 18, and 20-22 are also in condition for allowance by virtue of their dependency on allowable independent claims 1, 13, or 19. MPEP §2143.03 citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, Applicant respectfully requests withdrawal of the rejection to claims 2-7, 9, 11-12, 14-16, 18, and 20-22 for at least this reason also. Regarding the Examiner's additional assertions, which have not been addressed specifically, Applicant respectfully submits that these arguments are moot in view of the above remarks. Accordingly, in view of the above arguments, Applicant respectfully submits that claims 2-7, 9, 11-12, 14-16, 18, and 20-22 are in condition for allowance.

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In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 13-2725.

Respectfully submitted,

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